

## REMARKS

Reconsideration of the above-identified application as amended respectfully is solicited on behalf of the Applicant.

With the instant response, two (2) claims have been amended.

Claims 38-40 has been objected to on the basis on certain informalities. With the instant response, the informalities as to claim 38 and 40 have been corrected by changing "the third thermoplastic material" to "the second thermoplastic material" in order to provide proper antecedent basis. As to claim 39, antecedent basis for the recitation "the crystallization retarding component" may be found in claim 38 from which claim 39 depends wherein "a crystallization retarding component" is recited.

It is noted that claims 36 and 37 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over by Douchet, U.S. Patent No. 5,706,865, in view of Gray *et al.*, which is believed to be U.S. Patent No. 4,380,252 and not No. 4,380,242 as listed in the Office action.

Douchet has been cited as disclosing a multi-layer hose having a second layer of a hot melt polyurethane bonded to a first layer of a polyamide. Gray *et al.* has been cited as disclosing a multi-layer hose including an inner layer formed of a polyurethane material having a hardness of from about 75 Shore A to about 63 Shore D. The Examine is of the opinion that it would have been obvious to modify the polyurethane of Douchet to have a durometer of at least 63 Shore D as suggest by Gray *et al.* in order to harden and stiffen the hose to accept reinforcement without substantial deformation of the tube.

However, it is well-settled that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion, or incentive supporting the combination. *In re Geiger*, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987), citing *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1987), See also *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (noting that the "absence of such a suggestion to combine is dispositive in an obviousness determination"). The Federal Circuit has cautioned that the suggestion to combine requirement is a safeguard against the use of hindsight combinations to negate patentability. See *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998).

Applicants are mindful that evidence of a suggestion, teaching, or motivation to combine prior art references may be found not just in the references themselves, but also in the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved, although "the suggestion more often comes from the teachings of the pertinent references." *In re Dembiczak*, 175 F.3d at 994, 999 (Fed. Cir. 1999), citing *Rouffet*, 149 F.3d at 1355. Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the reason to combine must nevertheless be "clear and particular." *Winner Intern. Royalty Corp. v. Wang*, 202 F.3d 1340, 1348-49 (Fed. Cir. 2000), citing *Dembiczak*, 175 F.3d at 999. "Close

adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.' " *Dembiczak*, 175 F.3d at 999, quoting *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983).

In this regard, it appears that the second layer (3) of Douchet which the Examiner proposes to modify to have a durometer of at least 63 Shore D is in fact not a structural component of the hose (1), but rather is a very thin, *i.e.*, 0.05-0.1 mil, layer which is used as an adhesive or "bonding agent" to bond the reinforcement layer (4) to the polyamide core tube (2). [See, Douchet, at col. 2, ll. 63-65, and at col. 3, ll. 1-5]. Thus, in the Douchet construction, it appears that it is the polyamide core tube (2), and not the bonding agent layer (3), which supports the reinforcement (4). Such a construction appears to be in contrast to the that of Gray *et al.* wherein the core tube (12) is specified to have substantial hardness and stiffness to be self-supporting or dimensionally stable. [See, Gray *et al.*, at col. 2, ll. 40-48].

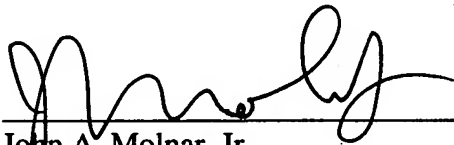
On this basis, Applicants submit that one of ordinary skill in the art following the teachings of Gray *et al.*, would not have been motivated to modify the polyurethane of Douchet in the manner proposed by the Examiner. That is, Gray teaches to provide a core tube (12) which is hard and stiff. However, as it is the polyamide core tube (2) of Douchet which appears to support the reinforcement layer (4), there would be seem to be no reason to harden or stiffen the bonding agent layer (3).

Of course, it might be assumed that it is always obvious to interchange materials that are known in the art. Such an assumption, however, would bespeak of the impermissible use of hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. See *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). Accordingly, Applicants submit that even if the combination proposed by the Examiner would have been sufficient to render the claimed invention obvious, there has yet to be articulated a suggestion or other motivation in the prior art or otherwise which would have lead one of ordinary skill in the art to have combined the cited references in the manner proposed.

Thus, it is submitted that independent claim 36, as well as dependent claim 37, should be considered to distinguish over the art made of record. Also, it is noted that claims 38-40 have not been rejected on the basis of any prior art, and therefore are believed to be independently patentable.

In view of the foregoing remarks, wherein the claim program as amended has been shown to clearly define the invention claimed as distinguishing over art made of record, the issuance of a Notice of Allowance is earnestly solicited.

Respectfully submitted,



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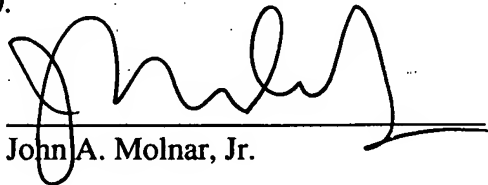
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I hereby certify that this correspondence is being deposited on March 14, 2006, with the United Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



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